

Further, the Office Action also discusses Figure 23 of Richardson. In Figure 23, a guidewire 170 has an elongate core member 171, a helical coil 181, and a polymer layer 191. See column 20, line 59 through column 21, line 10. As illustrated below in Figure 23, the distal end of the helical coil 181 does not extend distally of the distal end of the polymer layer 191.

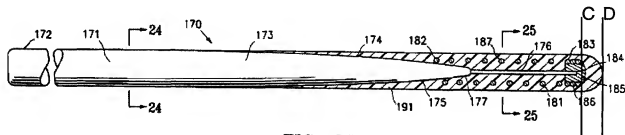


FIG. 23

In this illustrated Figure 23, lines C and D have been added. Line C shows the distal extent of the helical coil 181, and line D shows the distal extent of the polymer layer 191. As shown in this figure by the cross-hatching marks on the polymer layer 191, this first polymer layer 191 extends distally to line D.

It appears as though it is being asserted in the Office Action that the first polymer layer 156 of Figure 20 and the polymer layer 191 of Figure 23 are the equivalent of the tubular member of claim 1. Applicants do not take a position on whether these portions of Figures 20 and 23 can be the tubular member of claim 1. However, even assuming for the sake of argument that the first polymer layer 156 of Figure 20 and the polymer layer 191 of Figure 23 could be the tubular member of claim 1, it is evident from the above annotated figures that the helical coils (151, 181) of these embodiments do not extend distally of the distal end of either of the polymer layers (156, 191). As such, neither of these embodiments discloses a distal end of a coil member that extends distally beyond the distal end of a tubular member, as required by claim 1.

Although it does not appear as though Richardson discloses each and every element of claim 1, it was still asserted in the Office Action that Figure 23 shows a distal end of a coil that extends distally beyond the distal end of a tubular member. See, for example, the annotated version of Figure 23 shown on page 6 of the Office Action. Applicants respectfully assert that this is an inaccurate interpretation of the structures disclosed in Richardson; this reference does not disclose a distal end of a coil that extends distally of the distal end of a tubular member. Specifically, Applicants point out that the cross-hatching on the polymer layer 191 of Figure 23

shows that this polymer layer 191 actually extends all the way to the end of the device (as shown above by line D in illustrated Figure 23). Similarly, the cross-hatching on the first polymer layer 156 of Figure 20 shows that the distal extent of this first polymer layer 156 is line B (as shown above in illustrated Figure 20). Significantly, the Examiner appears to be interpreting these figures using entirely different standards. In discussing Figure 20 (see page 5 of the Office Action) it appears as though the Examiner is asserting that the first polymer layer 156 extends distally to the distal extent of the cross-hatching. However, in discussing Figure 23 (see page 6 of the Office Action), it appears as though the Examiner is asserting that the polymer layer 191 extends distally only to the line shown on page 6 of the Office Action rather than to the distal extent of the cross-hatching. Applicants respectfully assert that this interpretation of these figures is incorrect.

The cross-hatching in these drawings is a standard manner for showing such structures; the distal extent of the polymer layers (156, 191) is simply indicated by the distal extent of the cross-hatching showing these polymer layers (156, 191). As such, Applicants respectfully assert that the distal end of the polymer layer 191 of Figure 23 does not extend to the line shown on page 6 of the Office Action, but instead extends to line D as shown above in the illustrated Figure 23. Therefore, as mentioned above, neither Figure 20 nor Figure 23 show the distal end of a coil member extending distally beyond the distal end of a tubular member.

Because all elements of claim 1 are not disclosed in Richardson, this reference cannot render claim 1 obvious. Because they are dependent on claim 1 and because they recite additional patentably distinct elements, Applicants also assert that claims 3-7, 12 and 13 are allowable over this reference.

It was also apparently asserted in the Office Action that it would have been an obvious design choice to arrange elements of Figures 20 and elements of Figure 23 together to yield the structure of claim 1. Applicants respectfully traverse the Examiner's assertion that this would be an obvious design choice. In order to render a claim obvious each and every element of a claim must be present in the prior art and there must be some motivation to make the proposed combination. See M.P.E.P. §2143.01 and §2143.03. These requirements are not met by simply stating that the claimed combination would be an obvious design choice of a prior art structure.

In fact, M.P.E.P. §2144.04, Part VI, C, cites several cases that apparently stand for the proposition that rearrangement of parts can be an obvious design choice. However, in each of the cited cases all of the elements of the claims appear to be present in the references. In contrast, as stated above, Richardson does not disclose all elements of claim 1, and as such Applicants respectfully assert that claim 1 cannot be an obvious design choice of the structures shown in Richardson.

Further, *Ex Parte Chicago Rawhide*, 223 USPQ 351, appears to state that if the elements of the claim would be required to “coact” differently from the way they “coact” in the cited reference, then the claimed subject matter is not obvious. In the current case, providing for the arrangement of parts recited in claim 1 will lead to a device that has a different structure (or, stated another way, the parts are “coacting” differently) than the devices shown in Richardson. Because claim 1 and Richardson have a different structure in which parts are “coacting” differently, claim 1 cannot be considered an obvious design choice in view of Richardson.

Also, as explained in M.P.E.P. §2144.04, Part VI, C, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” (*citing Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). There is no motivation or suggestion in the prior art to make the proposed changes. For at least this additional reason, Applicants assert that the current claim 1 is not a design choice of the embodiments shown in Richardson, and claim 1 is allowable over this reference for at least this additional reason.

Because claim 1 is not an obvious design choice of the structures shown in Richardson, dependent claims 3-7, 12 and 13 are also not obvious design choices and Applicants assert that these dependent claims are allowable over this reference.

It was also apparently asserted in the Office Action that the design recited in claim 1 would be a mere change in the aesthetic design of Richardson. See page 9 of the Office Action, *citing In re Seid*, 161 F.2d 229, 231 (CCPA 1947). However, the device of claim 1 is structurally different from the devices shown in Richardson, and as such the differences between the device of claim 1 and the devices shown in Richardson are structural and/or functional

differences and are not aesthetic differences. As such, Applicants respectfully assert that claim 1 cannot be considered a changing of the aesthetic design of Richardson. For at least this additional reason, Applicants assert that claim 1, and claims 3-7, 12 and 13 which depend therefrom, are allowable over Richardson.

Claim 14 recites, in part, a guidewire comprising a core member and a distal assembly. The distal assembly includes a tubular member and a coil member. The distal assembly is connected to the core member such that a portion of the distal assembly extends distally beyond the distal end of the core member. Also, the distal end of the coil member extends distally beyond the distal end of the tubular member.

As mentioned above, Richardson does not disclose a distal end of a coil member that extends distally of the distal end of a tubular member. Further, the design recited in claim 14 is not an obvious design choice of, or an aesthetic variant of, the embodiments shown in Richardson. For at least these reasons, claim 14 is allowable over this reference. Because they are dependent on claim 14 and because they contain additional patentably distinct elements, Applicants also assert that claims 15 and 17, 21 and 22 are allowable over this reference.

Claim 59 recites, in part, a medical device comprising an elongated shaft and a distal assembly, the distal assembly including a tubular member and a ribbon or wire. A portion of the distal assembly extends distally beyond the distal end of the elongated shaft, and the ribbon or wire is connected to and extending distally beyond the distal end of the tubular member. It appears as though the Office Action is equating the coils of Figures 20 and 23 with the ribbon or wire of claim 59. However, as mentioned above, the coils of Figures 20 and 23 do not extend distally beyond the distal end of a tubular member, and as such Richardson does not disclose each and every element of claim 59. Also, the design recited in claim 59 is not an obvious design choice of, or an aesthetic variant of, the embodiments shown in Richardson. For at least these reasons, claim 59 is allowable over this reference. Because it is dependent on claim 59 and because it contains additional patentably distinct elements, Applicants also assert that claim 60 is allowable over this reference.

Claims 8, 11, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Palmer et al., U.S. Patent No. 6,544,231 (hereinafter "Palmer"). As mentioned above, all elements of claims 1 and 14 are not disclosed in Richardson. Further,

Palmer does not disclose the elements of claims 1 and 14 that are missing from Richardson. As such, the combination of Richardson and Palmer cannot render claims 1 and 14 obvious. Because they are dependent on claims 1 and 14 and because they recite additional patentably distinct elements, Applicants also assert that claims 8, 11, 18 and 20 are allowable over these references.


Claims 9, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson in view of Palmer further in view of Cook et al., U.S. Patent No. 5,213,111 (hereinafter "Cook"). As mentioned above, all elements of claims 1 and 14 are not disclosed in the combination of Richardson and Palmer. Further, Cook does not disclose the elements of claims 1 and 14 that are missing from Richardson and Palmer. As such, the combination of Richardson, Palmer and Cook cannot render claims 1 and 14 obvious. Because they are dependent on claims 1 and 14 and because they recite additional patentably distinct elements, Applicants also assert that claims 9, 10 and 19 are allowable over these references.

Reexamination, reconsideration, and withdrawal of the outstanding objections and rejections are respectfully requested. It is submitted that all pending claims are now in condition for allowance, and the issuance of a Notice of Allowance in due course is respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their attorney,

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